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John R. Klug

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DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER, CO 80202-5647

EXAMINER

LAZARO, DAVID R

ART UNIT

PAPER NUMBER

2155

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/673,073	Applicant(s) KLUG, JOHN R.	
	Examiner DAVID LAZARO	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-58 and 60-66 is/are pending in the application.
- 4a) Of the above claim(s) 45-58 and 60-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/28/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed 04/09/2008.
2. Claim 44 was amended.
3. Claims 1-27, 59 are canceled.
4. Claims 45-58 and 60-66 are withdrawn.
5. Claims 28-44 are pending in this office action.

Response to Amendment

6. The terminal disclaimer filed on 02/28/08 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Application 11/425,079 has been reviewed and is accepted. The terminal disclaimer has been recorded.
7. The provisional double patenting rejection of claims 28 and 43 is withdrawn based on the terminal disclaimer filed 02/29/08 and accepted 03/24/08.
8. The rejection of claim 44 under 35 USC 101 is withdrawn based on applicant's amendment.
9. Applicant's arguments filed 04/09/08 have been fully considered but they are not persuasive. See Response to Arguments below. Accordingly, the grounds of rejection as presented in the 10/29/07 office action are maintained. This office action is made FINAL.

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10. The information disclosure statement (IDS) submitted on 02/28/08 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 28-31, 33, 34, 40, 42 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2002/0120705 by Schiavone et al. (Schiavone).

13. With respect to claim 28, Schiavone teaches a computer-implemented method for receiving and processing communications according to a value, comprising:

determining whether the communication is associated with a frank, the frank corresponding to a value (Page 2 [0017] - email is checked for priority information which may be in many forms and may have a value associated with it);

in response to determining the communication is not associated with a frank, processing the communication according to at least one default rule (Page 3 [0020]-

[0021] - default priorities may be used or other information besides a specific priority indicator will be used for processing); otherwise

determining a class to which the frank corresponds (Page 2 [0017] and [0012]: priority information can be indicative of a class);

in response to determining the class to which the frank corresponds, processing the communication according to at least one class-based rule (Page 3 [0018] - message is handled based on class identified by priority - also see Page 4 [0030]).

14. With respect to claim 29, Schiavone further teaches wherein the step of processing the communication comprises: determining whether the frank corresponds to a class which is less than a specified minimum class; and in response to determining the frank corresponds to a class which is less than a specified minimum class, discarding the communication (Page 4 [0030] - lowest priority class of message may be rejected and not delivered).

15. With respect to claim 30, Schiavone further teaches the step of, in response to determining the frank corresponds to a class which is not less than a specified minimum class, transmitting the communication from a network node to a recipient system (Page 4 [0030] - classes of appropriate higher priority will be delivered).

16. With respect to claim 31, Schiavone further teaches where the communication is transmitted by way of at least one Internet service provider (Page 2 [0014] - ISP can carry out the invention).

17. With respect to claim 33, Schiavone further teaches wherein the step of processing the communication according to at least one class-based rule further

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comprises: determining whether the class is less than a specified minimum class; and in response to determining the class is less than a specified minimum service class, delaying delivery of the communication (Page 4 [0030] - delivery of lowest priority class of message may be delayed).

18. With respect to claim 34, Schiavone further teaches wherein the step of processing the communication according to at least one class-based rule comprises: determining whether the class is less than a specified minimum class; and in response to determining the class is less than a specified minimum class, placing the communication in a recipient-specified location (page 1 [0007] - routing to junk folder).

19. With respect to claim 40, Schiavone further teaches wherein the communication is an electronic mail (Page 2 [0012] email).

20. With respect to claim 42, Schiavone further teaches receiving a second communication; determining whether the second communication includes a second frank (Page 2 [0017] - would apply to all communications); in response to determining the second communication does include a second frank, determining a second class to which the frank corresponds (Page 2 [0017] and [0012]: each communication is checked for priority information); and determining a display order for the first and second communications, the display order based on the first class and the second class (Page 4 [0030] - recipient will receive mail in an order that is both determined based on the time of the incoming communication and the respective classes of the incoming communications).

21. Claim 43 is rejected based on the same logic of claim 28.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone.

24. With respect to claim 32, Schiavone teaches all the limitations of claim 28, and further teaches that generally any type of rule can specify the processing for the message of any particular identified priority (Page 4 [0030]). Schiavone further teaches distinguishing between different levels of priority in terms of establishing a priority hierarchy and discarding communications based on differences in the priority levels (Page 4 [0030]).

Schiavone does not explicitly teach that if a rank is determined to be of a class that is greater than a minimal class, then the communication is discarded. However, one skilled in the art would readily recognize that a ranking scheme can be reversed and still carry out the same functionality. For example, it is common knowledge that one could rank levels from 1-10 with either 1 meaning the lowest or least important, 10 being the highest, or reverse it and have 1 meaning the highest or most important and 10 being the lowest. It is essentially a matter of perspective in how one chooses to label the levels. The corresponding functionality of the meaning attached to the corresponding label remains the same.

As such, it would have been obvious to one of ordinary skill in the art to substitute one ranking scheme for another for the predictable result of message processing based on the actual meaning of the ranking.

25. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone in view of U.S. Patent 5,694,616 by Johnson et al. (Johnson).

26. With respect to claim 35, Schiavone teaches determining whether the frank corresponds to a class greater than or equal to a specified minimal class (Page 4 [0040]).

Schiavone does not explicitly disclose in response to determining the frank corresponds to a class greater than or equal to a specified minimum class, displaying at least a portion of the communication in a specified color. Johnson teaches that email messages that are determined to be of greater importance can be displayed in a specified color or with a particular icon (Col. 1 lines 34-42). This is done to reflect the important status of the message.

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of displaying a high priority message in a specified color as disclosed by Johnson to further improve the priority system of Schiavone for the predictable result of reflecting the higher priority of a particular message.

27. Claim 36-39 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone in view of U.S. Patent 6,393,464 by Dieterman (Dieterman).

28. With respect to claim 36, Schiavone does not explicitly disclose determining whether a characteristic of a sender of the communication matches at least one entry on an approved list; and in response to determining the characteristic of the sender matches at least one entry on the approved list, ignoring the step of processing the communication according to at least one class-based rule.

Dieterman teaches determining if a characteristic of a sender of a communication matches information of an approved list (Col. 5 lines 24-35). If the sender is on the approved list, the message is delivered without any further processing. This allows for control of the delivery of electronic communications (Col. 3 lines 20-25).

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of determining if the characteristic of a sender matches at least one entry on an approved list as taught by Dieterman, to improve the messaging system of Schiavone for the predictable result of controlling delivery of electronic communications.

29. With respect to claim 37, Schiavone further teaches wherein the characteristic of the sender is one of an electronic mail address, a name, or an Internet protocol address (In Dieterman: Col. 3 lines 55-65).

30. With respect to claim 38, Schiavone teaches determining whether a characteristic of a sender of the communication matches at least one entry on an approved list; and in response to determining the characteristic of the sender matches at least one entry on the approved list, assigning a second class to the communication.

Dieterman teaches determining if a characteristic of a sender of a communication matches information of an approved list (Col. 5 lines 24-35). If the sender is on the approved list, the message is marked as not requiring approval. This allows for control of the delivery of electronic communications (Col. 3 lines 20-25).

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of determining if the characteristic of a sender matches at least one entry on an approved list as taught by Dieterman, to improve the messaging system of Schiavone for the predictable result of controlling delivery of electronic communications.

31. With respect to claim 39, Schiavone further teaches wherein the step of processing the communication according to at least one class-based rule comprises applying the class-based rule to the higher class of the class and the second class (In Schiavone Page 3 [0018]-[0020]: trusted sender priority is ranked the highest and considered first).

32. Claim 44 is rejected based on the same logic of claim 39.

33. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone in view of U.S. Patent 6,301,608 by Rochkind (Rochkind).

34. With respect to claim 41, Schiavone further teaches the invention generally applies to network communications (Page 2 [0012]).

Schiavone does not explicitly disclose the communication is a telephone call.

Rochkind teaches a system that uses priority information to process communications (Col. 2 lines 28-33 and line 64 - Col. 3 line 16). Such communications includes telephone calls (Col. 3 line 56 - Col. 4 line 6).

Because both Schiavone and Rochkind process communications based on priority information, it would have been obvious to one skilled in the art to substitute telephone calls as a network communication in order to achieve the predictable result of processing communication based on the priority information of the communication.

35. Response to Arguments

36. Applicant's arguments filed 04/09/08 have been fully considered but they are not persuasive.

37. Applicant argues on pages 9-10 - "A. *Independent claim 28 is patentable because Schiavone fails to disclose determining a class to which a frank associated with a communication corresponds... As described above, Schiavone discloses attaching a priority flag to an incoming message to determine how to deliver the message. However, Schiavone does not disclose an active step of determining a class to which the frank corresponds... See Schiavone, para. 0017. In other words, as described by Schiavone, priority of the email can be based on information about the email or a description of the type of email. However, the examples provided above are instances of different priority flags, not classes to which the priority flags correspond. As evident from the above quote, the category of an email, i.e. "Internal Business Communication," is a priority flag similar to the "Highest Priority" priority flag. Schiavone provides many examples of priority flags, but simply fails to disclose priority flags corresponding to a class.*"

a. Examiner's Response: Applicant has not made it clear as to how "instances of different priority flags" does not correspond to different classes. In Paragraph [0012], Schiavone explicitly states,

*"Conceptually, the present invention **controls distribution of network communications**, e.g. e-mail messages (collectively, "e-mail messages"), in a priority manner or pursuant to an industry supported standard regarding **specific classes of service**, e.g., BUSINESS PRIORITY (IMMEDIATE DELIVER, high cost) or PERSONAL PRIORITY (QUICK DELIVERY, moderate cost), etc."* (emphasis added)

Clearly, the priority levels of Schiavone are indicative of a class. For example, all messages with a BUSINESS PRIORITY belong to a BUSINESS priority class of messages just as all messages with a PERSONAL PRIORITY belong to a PERSONAL priority class. The class a message belongs to subsequently determines how the message is processed (immediate versus quick delivery for example).

The active process of determining a priority level (i.e. class of message) and processing according to the priority level rule can easily be seen in Fig. 1 and in paragraph [0017]. Particularly, a message will have some priority flag or other mechanism such as a header or marking which the examiner interprets as being a flag. The flag or other mechanism is subsequently used in determining the priority level (such as the example business and personal levels), which the examiner interprets as being the corresponding class. The other exemplary priority levels discussed in paragraph [0017] are also indicative of a class. The priority level (class) determines a priority based rule (class based rule) for

processing the message. The claimed subject matter and specification does not indicate any particular requirements for the meaning of 'class', nor is there any restriction claimed on the types of classes that may be used. As such, the examiner considers the teachings of Schiavone to be within the scope of the claimed subject matter. Applicant has not shown how the claimed subject matter is distinguished from the prior art.

38. Applicant argues on page 10 of the remarks - *"Irrespective of whether priority flags can be indicative of class, there is no positive step in Schiavone of actively 'determining a class to which the frank corresponds,' which would be necessary to support a rejection under 35 U.S.C. §102."*

b. Examiner's response - Figure 1, step 14 states "identifying a priority level for the email message" (see also the beginning of paragraph [0017]). As the examiner interprets the priority level as corresponding to a class, it is clear that there is positive step of actively "determining a class to which the frank corresponds". Applicant's arguments are not persuasive.

39. Applicant argues on page 10 of the remarks - *"Moreover, even if priority is indicative of a class, Schiavone would only describe one class, namely 'priority.' Hence, there would be no reason to determine the class to which the frank corresponds because they would all be in the same class. Because Schiavone fails to disclose 'determining a class to which the frank corresponds', Schiavone cannot anticipate this claim."*

c. Examiner's response - As noted in the examiners response of paragraph .a. above, Schiavone describes several different example priority levels and how

they are indicative of different classes of service such as immediate versus quick delivery. It is nonsensical to say that priority in Schiavone is all one class as Schiavone clearly processes messages differently according to the identified priority level. This is the fundament concept described in paragraph [0012]). Applicant's reasoning would contradict, for example, the steps of Fig. 1 in Schiavone. Applicant's arguments are not persuasive.

40. Applicant's remaining arguments rely on the reasoning of the arguments discussed above and are therefore addressed by the responses above.

Conclusion

41. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID LAZARO whose telephone number is (571)272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Lazaro/
Primary Examiner, Art Unit 2155
July 24, 2008